

JANET K. YAMAMOTO et al.
Serial No.: 07/739,014
Page 2

please cancel "B, E" and substitute therefore --Figs. 2B and 2E-- ; and line 17, please cancel "C, F" and substitute therefore -- Figs. 2A and 2D--.

Page 9, line 10, please cancel "8A" and substitute therefore --9A--; and line 11 please cancel "8B" and substitute therefore --9B--.

Page 36, line 36, please cancel "Table 1" and substitute therefore --Table 2--.

Page 41, line 36, please cancel "Table 1" and substitute therefore --Table 2--.

In the Claims:

Please cancel claims 11-13.

REMARKS

Claims 1-10 were examined, with claims 11-13 having been withdrawn pursuant to a restriction requirement. Claims 11-13 have been canceled. Re-examination reconsideration of the claims as amended, are requested in view of the following remarks.

Status of parent application Serial No. 07/618,030, has been clarified on page one of the application.

In view of the finality of the restriction requirement, applicants have canceled all non-elected claims, without prejudice to refiling in a subsequent application.

The informalities noted by the Examiner in the specification have been corrected. In particular, the reference to Figs. 2A-2F on page 4 of the application have been corrected to match the proper figures. The references to Table 2 and Figs. 9A and 9B have also been corrected.

Claims 1-10 have been rejected for statutory double patenting under 35 U.S.C. 101 in view of copending application Serial No. 07/726,061. Such rejection is respectfully traversed.

Statutory or "same invention" double patenting occurs only when the identical invention is being claimed in both applications. Looked at the other way, statutory double

patenting is avoided when "one of the claims could be literally infringed without literally infringing the other." MPEP Section 804.

In the present application, the claims are directed generically at vaccines and methods for their use. In copending application Serial No. 07/726,061, the claims are directed specifically at particular cell lines. Thus, the claims of the present application could be literally infringed (e.g. by the use of non-cell vaccines or cellular vaccines derived from cell lines other than those specifically claimed in the copending application) without literally infringing the claims of copending application Serial No. 07/726,061.

For these reasons, the section 101 double patenting rejection is an error and should be withdrawn.

Claims 1-10 were also rejected under 35 U.S.C. 101 for lack of utility. In particular, the Examiner questions the ability of the vaccines prepared according to the present invention to protect against heterologous challenge.

Without admitting the propriety of such rejection, applicants submit the Declaration of Dr. Janet K. Yamamoto, one of the inventors herein. Said Declaration authenticates data presented in a manuscript of Dr. Yamamoto, (Exhibit A to the Declaration) which manuscript is being prepared for a submission and eventual publication. The data in the manuscript clearly demonstrate success and protection against heterologous challenge using the vaccines of the present invention. See pages 8-11 of the manuscript. Thus, it is believed that the rejection for lack of utility has been overcome.

The specification was objected to and claims 1-10 rejected under 35 U.S.C. 112, first paragraph, for failure to provide an enabling disclosure. The Examiner states that the specification is not enabled for the production and the use of the claimed vaccine because the utility of the invention has not been proven.

While applicants do not admit the propriety of such rejection, applicants will rely on the data provided in the manuscript accompanying the Declaration of Dr. Yamamoto to support utility, as described above.

Claims 4 and 10 were rejected under 35 U.S.C. 102(a) as being anticipated by Jarrett et al. (1991). Such rejection is respectfully traversed.

The data presented in the Jarrett et al. (1991) application were generated by the work of Dr. Janet K. Yamamoto, one of the inventors herein. This fact is substantiated in Dr. Yamamoto's Declaration. As the Jarrett et al. (1991) publication represents the work of one of the inventors herein, and was published less than one year prior to the filing date, it is not available as a reference under 35 U.S.C 102(a).

Claims 1-10 were provisionally rejected under 35 U.S.C. 102(e) over copending application Serial No. 07/726,061. Such rejection is respectfully traverse for the following reasons.

35 U.S.C. 102(e) requires the reportedly prior art patent be granted "on an application for patent by another filed in the United States before the invention thereof by applicant...." As the specification of the present application and copending application Serial No. 07/726,061, are essentially identical, it is not understood how the invention in the present application could possibly have been made after the copending application was filed. In an effort to further clarify this situation, however, the accompanying Declaration of Dr. Janet K. Yamamoto specifically addresses the issue of timing and sets forth that the present invention was made prior to the filing of copending application Serial No. 07/726,061.

The Examiner has also raised the issue of priority under 35 U.S.C. 102(g) between the present application and copending application Serial No. 07/726,061. No question of priority is believed to be at issue.

JANET K. YAMAMOTO et al.
Serial No.: 07/739,014
Page 5

Priority questions arise only when two applications claim a single invention. As described above, the present application is directed generically at vaccines and their use in vaccination methods. Copending application Serial No. 07/726,061, in contrast, is directed only at a particular species of FIV-infected cell lines, which cell lines may be useful as vaccines. Such a generic-species relationship between the two applications does not raise issues of priority.

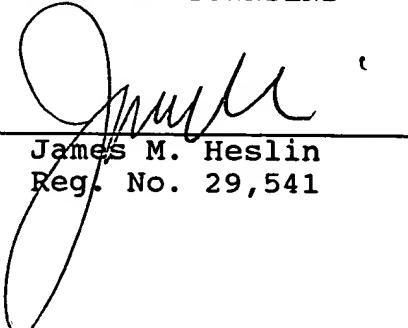
In view of the above amendments and remarks, applicants respectfully submit that all claims are now in condition for allowance and request that the application be passed to issue at an early date.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at (415) 326-2400.

Respectfully submitted,

TOWNSEND and TOWNSEND

By


James M. Heslin
Reg. No. 29,541

TOWNSEND and TOWNSEND
One Market Plaza
Steuart Street Tower
20th Floor
San Francisco, California 94105

(415) 543-9600

JMH:ge